

The Office Action had set an initial deadline of April 7, 2006. Accordingly, a petition for a one-month extension accompanies this submission. However, if the undersigned is incorrect, please charge the appropriate amount to Jones Day Deposit Account Number 50-2468.

### **REMARKS**

#### **1. Restriction of Claim 37 into separate inventions**

The examiner has issued a restriction requirement dividing Claim 37 into nine (9) separate inventions (groups 3 -11). Applicants believe the restriction of a single claim into different inventions to be in error and request that it be withdrawn for the reasons stated below:

##### **A. Claim 37 depends from and defines the same essential features as Claim 36**

Claim 37 depends from Claim 36 and merely enumerates, in Markush format, a number of exemplary conditions treatable or preventable by the compositions and methods of the present invention. As explained in MPEP 806.03: "Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." Because Claim 37, by introducing limitations to specific diseases treatable or preventable by the invention, simply provides different definitions of the subject matter embraced by Claim 36, only varying in their breadth or scope of definition, restriction between Claims 36 and 37 is improper. Thus, claims 36 and 37 define the same essential characteristics of the invention and should be examined together.

##### **B. Restriction Between Diseases Treatable by the Same Invention is Improper**

Applicants further respectfully submit that restriction among the conditions treatable or

preventable by the invention (bacterial, viral, fungal, cancer, allergy, cardiovascular, asthma, arthritis, and psoriasis), as enumerated in claim 37, is improper because “it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.” MPEP 806.01. Because it is the fusogenic vesicles and their preparation or use which constitute the claimed invention and not the condition treated or prevented, it is improper to restrict the invention to conditions treatable or preventable by it. For this reason, applicants respectfully traverse and request reconsideration and withdrawal of the restriction requirement as applied to the diseases treatable or preventable by the invention.

**C. A single search for the essential features of the invention would reveal pertinent art across a variety of conditions and applications**

In order to justify restriction of claim 37 into separate inventions, the examiner would have to show one of the following: A) separate classification, B) separate status in the art, or C) different field of search. MPEP 808.02. As to the first requirement, as stated explicitly in the Office Action, all nine groups of inventions are drawn to the same class (424) and subclass (450). Concerning the second requirement, the examiner has failed to cite patents or demonstrate otherwise that each Markush member enjoys separate status in the art. Finally, applicants respectfully submit that examination of claim 37 would not require different fields of search. Different fields of search exist when it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other inventions. MPEP 808.02. Because the subject matter of the present invention is directed to the fusogenic vesicles and methods of making and using them, a search for the essential features of the fusogenic vesicles will yield results regardless of their application, i.e. a single search would reveal the closest art whether used for the treatment of fungal, viral, bacterial, or any other type of disease. As a

consequence, applicants respectfully traverse the restriction requirement and request its reconsideration and withdrawal with respect to claim 37.

**2. Claim 36 depends from and otherwise incorporates all limitations of Claim 1**

Applicants respectfully submit that because claim 36 depends from and otherwise incorporates all limitations of Claim 1, claim 36 should be eligible for rejoinder with the elected group I (claims 1-16 and 38).


**CONCLUSION**

Based on the foregoing, applicants respectfully request that the Examiner reconsider and modify the restriction requirement with respect to claims 36 and 37, as outlined above.

Respectfully submitted,

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